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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,401	01/22/2004	James Charles Bohling	A01485	9626

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ROHM AND HAAS COMPANY
PATENT DEPARTMENT
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EXAMINER

MONDESI, ROBERT B

ART UNIT PAPER NUMBER

1653

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,401

Applicant(s)

BOHLING ET AL.

Examiner

Robert B Mondesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to amendment filed October 13, 2004. **Claims 8 and 12** have been cancelled. **Claims 1-7 and 9-11** are currently pending. **Claims 7, 9-10** have been amended.

Withdrawal of Objections and Rejections

The rejection of **claims 8 and 12** under 35 U.S.C § 112, first paragraph is withdrawn.

The rejection of **claims 8 and 12** under 35 U.S.C § 112, second paragraph is withdrawn.

The rejection of **claims 1, 3 and 4** under 35 U.S.C § 102(b) as being anticipated by Ede et al. is withdrawn.

The rejection of **claims 7-8** under 35 U.S.C § 102(b) as being anticipated by Kang et al. is withdrawn.

The rejection of **claims 7-8** under 35 U.S.C § 102(b) as being anticipated by Bray et al. is withdrawn.

The provisional rejection of **claims 7-8** under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **claims 14-22, and 46** of copending Application No. 10/786532 is withdrawn.

Maintenance of rejections

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 and 9-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection was explained in the previous Office action.

Claims 1-7 and 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection was explained in the previous Office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-6 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Weber et al. United States Patent 5,198,531.

This rejection was explained in the previous Office action.

Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Ede et al. United States Patent Application Publication US 2002/0076835.

Claim 7 is product by process claims and even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Presently as amended the claim reads on any biologically active substance that is free of chlorotriyl linker resin. Ede et al. disclose many biologically active substances that are free of chlorotriyl linker resin (Table 1, Examples 1-12). Thus Ede et al. teach all the elements of **claim 7** and these claims are anticipated under 35 USC 102(b).

Response to applicant's arguments

In view of failing to comply with the written description requirements, the applicants seem to not have understood the rejection. The rejection is in regards to a process of determining the biological activity of the mentioned FRAGMENT of a biologically active substance. The applicants have incorrectly assumed that the rejection is in view of a process of determining the biological activity of a peptide; furthermore the

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applicants are reminded that none of the claims use the word peptide and therefore the applicants arguments to not address actual claimed subject matter.

In view of the rejections made under 35 U.S.C. 112, second paragraph, the applicants assert that the specification is amended to define CT-AA and FOMOC acid. The examiner would like to respond by stating the introduction of such information in the specification in form of an amendment to the specification is considered to be new matter and is not allowed. Please view the new rejection section of this Office action.

The applicants assert that in contrast to the present invention, the disclosure of Webber concerns a substance made from a 2' chlorotriptyl chloride resin and that Webber specifically indicates that the alcohol functional group "must be converted to a chloride prior to loading.

The examiner would like to point out that Webber also introduces an alternative pathway wherein the resin is converted to an amine prior to loading (column 5, lines 46-47). Furthermore the claims do not state that the trityl alcohol resin is converted to an amine prior to loading nor do they state that the trityl alcohol resin is converted to a chloride prior to loading. In fact none of the claims make any reference to loading of any compound with regards to the process of the invention.

New rejection(s) or objections

Specification

The amendment filed October 13, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added

material which is not supported by the original disclosure is as follows: The applicants have amended the specification to define the following phrases CT-AA and FMOC. The mentioned definitions were not part of the disclosure as initially filed and hence in introduce new matter not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

The disclosure is objected to because of the following informalities: This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth below: Nucleic acid sequences longer than 10 nucleotides and amino acid sequences longer than 4 residues need to be designated with a sequence identifier. Applicants must correct the sequence submissions in the specification on: (page 23, lines 25), (page 26, line 15, 19-20 and 24).

Conclusion


No claims are allowed

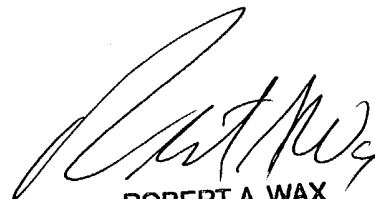
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B Mondesi whose telephone number is 571-272-0956. The examiner can normally be reached on 9am-5pm, Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Robert B. Mondesi
Patent Examiner
Group 1653
12-12-04


ROBERT A. WAX
PRIMARY EXAMINER
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